

Application Serial No. 10/669,238
Reply to Office Action dated April 4, 2006

**EXPEDITED HANDLING PROCEDURE
PURSUANT TO 37 C.F.R. § 1.116**

REMARKS/ARGUMENTS

On page 2 of the Office Action, the Examiner outlines a rejection to claim 45 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner argues that the previous amendment to claim 45 concerning adding about 0.1% to 1% of carboxymethyl cellulose as a portion of the plant protein ingredient is incorrect, particularly given that the limitation is not supported by the original disclosure. That is, the Examiner asserts that carboxymethyl cellulose is not added as a portion of the plant protein ingredient. In order to address this concern, claim 45 has been amended to merely state that Step A including adding the portion of carboxymethyl cellulose. The Applicant respectfully requests that this amendment be entered after final as the amendment removes issues for a potential appeal and will only require a cursory review by the Examiner.

The remaining claims presented in the application, i.e., claims 1-48, currently stand rejected. More specifically, claims 1-11, 14-25, 28-30, 37, 38 and 43-48 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ringe in view of Sander. Claims 12, 13, 26, 27, 31-36 and 39-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ringe in view of Sander and further in view of Van Lengerich et al. In essence, the Examiner argues that the claims presented in the present application simply combine known ingredients in the art without producing any unexpected results. Thus, having found references which teach each of the individual ingredients presented in the claims, the Examiner holds that it would have been obvious to one of ordinary skill in the art to make the cereal product containing both fiber and protein as specifically claimed. These rejections are respectfully traversed for the reasons set forth below.

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Initially, the Applicant respectfully submits that the Examiner is improperly shifting the burden of proof onto the Applicant to prove unexpected results obtained by the combination of ingredients presented in accordance with the present invention without initially establishing a *prima facie* case of obviousness. That is, the Applicant submits that the Examiner is simply combining references in the prior art which contain individual ingredients presented in the claims of the present application without any motivation to combine the ingredients as claimed other than a broad statement that it is obvious to one of skill in the art to add, for example, a high amount of protein to the Ringe cereal product when desiring a product having a high fiber and protein content. The Examiner goes on to state that adding an ingredient for its known purpose would have been obvious to one of ordinary skill in the art. This position is not supported by existing case law. For example, the U.S. Courts of Customs and Patent Appeals stated in *In re Spinnoble* that a patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (*In re Spinnoble* 56 CCPA 823) (emphasis added). The fact remains that the art must provide the proper motivation for the combination, rather than the combination being just considered obvious by the Examiner who is well beyond one of ordinary skill in the art.

Moreover, the Applicant submits that the Examiner recognizes the deficiencies in Ringe, at least with respect to the inclusion of any protein ingredient, the timing of adding protein, the amount of protein included, the particle size of the fiber, the puff frying and the addition of a high potency sweetener. The Examiner then cites Sander, which is directed to a high protein cereal, and holds that it would be obvious of one of ordinary skill in the art to add the high protein ingredients of Sander to Ringe. All the other features are just held as obvious without any specific teaching in the art. The Examiner then, still without any motivation, includes Van Lengerich et al. in the combination to further add inulin to the products.

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The Applicant would again like to emphasize that the test for patentability under 35 U.S.C. §103 is basically whether the differences between the claimed subject matter, considered as the whole, and the prior art would have been obvious at the time the invention was made. Reaching this determination, the skill and content of the prior art, the differences between the prior art and the claimed subject matter and the level of ordinary skill in the art must be considered, along with the relevant secondary issues. *Graham v. John Deere Co.*, 381 U.S. 1, 148 USPQ 459 (1966).

A proper rejection under 35 U.S.C. §103 cannot be based on hindsight knowledge of the invention under consideration for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd. v. Union Oil Co. of Cal.* 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, ... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is, however, simply irrelevant (emphasis added). Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art (Case citations).

In the art of food sciences, there is a set list of ingredients approved by the FDA for human consumption. All food products contain one or more ingredients from that list. In short, inventors are limited to their choice of ingredients to combine to produce novel food products. In the present situation, a cereal product with both insoluble and soluble fiber ingredients is known. In addition, a cereal with a protein ingredient is known. All of these ingredients are on the list of FDA approved ingredients. However, this just indicates that pieces of the present invention were known, which is irrelevant. None of

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the prior art discloses or suggests the combination of the multiple forms of fiber and the plant protein ingredient claimed. Again, the Ringe patent has been around for over a decade and the Sander patent has been around for years as well, still there does not exist any reference to the claimed combination of ingredients, nor any suggestion or motivation to combine. The Examiner appears to hold that the combination as obvious simply because all the pieces of the invention are known. As set forth above, the courts have already ruled against taking such a position. Moreover, if a manufacturer wishes to produce a product that will meet with FDA approval, all the ingredients must be on the list of FDA approved ingredients. That is, existing food items are combinations of known ingredients. It is the combination, processing and final product that form the invention. Thus, without a motivational teaching in the art to combine the known ingredients in the manner specifically claimed, the Applicant respectfully submits that the Examiner has not satisfied her burden of establishing a prima facie case of obviousness.

Further, the CAFC in *In re Gordon*, 221, USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Holst & Derrick Co., v. Sowa & Sons, Inc.*, 220 USPQ 763, 771 (1984) quoted:

A patentable invention... may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

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Again, the combination of ingredients must be suggested in the art, not simply held as obvious just because all the ingredients can be individually found in various references. Along these lines, references must be evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. *In re Shuman and Meinhardt*, 150 USPQ 54 (CCPA 1966). In the present situation, the invention addresses the problems with dry, short lived, highly frangible features of high insoluble fiber products, gummy or slimy consumption features of high soluble fiber products, and decreased starchy constituents in connection with at least high protein products in arriving at a high insoluble fiber, high soluble fiber and high protein ingredient cooked dough product that has superior organoleptic attributes or qualities as discussed in the specification. It is respectfully improper to combine the prior art, which does not equally address these problems or arrive at the inventive solution, by simply piecing together ingredients from various references. As a whole, Ringe is not concerned with a high protein product. As a whole, Sander is not concerned with a high multi-fiber product. Simply stated, neither Ringe nor Sander suggest making a combination high multi-fiber and high protein cooked dough product and it is not permissible for the suggestion of the combination to simply come from the Examiner for a proper prima facie case of obviousness. That is, it is clear that it is the PTO that has to establish a prima facie case of obviousness and "obvious can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentives supporting the combination." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and *Ray Geiger*, 815 F.2d 686 (Fed. Cir. 1987).

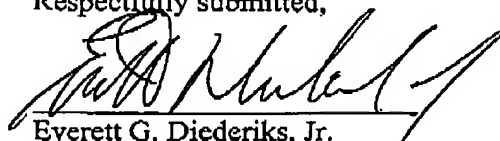
In a similar manner, Van Lengerich et al. is not concerned with a high insoluble fiber, high soluble fiber and high plant protein product such that the mere fact that Van Lengerich et al. teaches to make a cereal dough with inulin does not detract from the inventiveness of the combination set forth in this application.

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Based on the above, it is respectfully requested that both the formal and prior art rejections be withdrawn, the claims allowed and the application passed to issue. If the Examiner should have any additional concerns regarding the allowance of the application that can be readily addressed, she is cordially invited to contact the undersigned at the number provided below in order to further expedite the prosecution.

Respectfully submitted,



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